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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

HUNT, J

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

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12/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/366,458

Applicant(s)
Dreyer

Examiner
Jennifer Nichols, Nee Hunt

Group Art Unit
1642



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-49 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-49 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1642

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, and 23-24 drawn to a method of obtaining an enriched composition, classified in class 436, subclass 501.
 - II. Claims 11-21, drawn to a method of identifying a cell type, classified in class 435, subclass 7.2.
 - III. Claim 22, drawn to a cell, classified in class 435, subclass 325.
 - IV. Claims 25-26, drawn to a method of delivering an agent to a specific cell type, classified in class 436, subclass 501.
 - V. Claims 27-33, drawn to a method of treating a cell proliferative disorder, classified in class 424, subclass 178.1.
 - VI. Claims 34-38, drawn to a method of detecting a cell proliferative disorder, classified in class 435, subclass 7.1.
 - VII. Claims 39-40, drawn to a method of detecting a polynucleotide variation, classified in class 536, subclass 24.33.
 - VIII. Claims 41-45, drawn to a method of producing a lineage specific cell type, classified in class 435, subclass 383.
 - IX. Claims 46-49, drawn to a method of maintaining a lineage specific cell type, classified in class 435, subclass 374.

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2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions of Groups I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the cell of Group III can be made by a distinct process, for example binding to an alternative cell surface marker, or by mechanical sorting techniques.

The method of Groups I-II and IV-IX are completely different methods , having different starting points, different method steps, and different outcomes. The method of Group I begins with a population of cells, and sorts them, using a binding agent. The method of Group II begins with a cell and determines it's type using detection of a receptor. The method of Group IV begins with an agent, and delivers it to a cell with a specific ligand. The method of Group V begins with an antibody coupled to a factor and administers it to a cell to inhibit the cell's growth. The method of Group VI begins with an antibody coupled to a factor and uses it to detect a particular kind of cell. The method of Group VII begins with a nucleic acid and uses it to detect nucleic acid variations. The method of Group VIII begins with a population of cells and uses an agent to commit them to a specific lineage type. The method of Group IX uses a lineage maintaining agent to maintain cells of a specific lineage. As set forth herein, these are completely different methods, which are patentably distinct in their materials, steps, and outcomes.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

5. A telephone call was made to on to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Nichols, whose telephone number is (703) 308-7548. The examiner can normally be reached Monday through Thursday 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached at (703) 308-3995. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Communications via internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [anthony.caputa@uspto.gov].

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All internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists the possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist, whose telephone number is (703) 308-0196.

Jennifer Nichols, Nee Hunt

December 17, 2000

Brenda Brumback
BRENDA BRUMBACK
PATENT EXAMINER